

REMARKS

I. Introduction

Claims 1 to 10 are pending in the present application. In view of the foregoing amendments and following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Objection to the Drawings

The drawings were objected to under 37 C.F.R. § 1.83(a). The Final Office Action states that roller bearing (claim 3), the X arrangement (claims 3 and 7) and the second angular roller bearing (claim 7) must be shown in the drawings or the features canceled from the claims. See Final Office Action at p. 2.

Applicant respectfully disagrees with the merits of this rejection. To expedite prosecution, however, Applicant herein submits a new drawing sheet including new Figure 3 illustrating the X arrangement of the bearings. No new matter has been added. See the Specification, for example, at page 4, lines 19 to 29. Accordingly, withdrawal of the objection to the drawings is respectfully requested.

III. Rejection of Claims 1, 2 and 10 Under 35 U.S.C. § 102(b)

Claims 1, 2 and 10 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 2,883,020 ("Kuemmich et al."). It is respectfully submitted that Kuemmich et al. do not anticipate claims 1, 2 and 10 for the following reasons.

Claim 1 relates to a parking lock mechanism for an automotive transmission by which a transmission shaft mounted with roller bearings is lockable with respect to a transmission housing. Claim 1 recites that the parking lock mechanism includes a roller bearing outer race, an arrangement configured to connect the roller bearing outer race in a form-fitting, rotationally fixed manner to the transmission housing, and an axially displaceable body connectable in a rotationally fixed manner to the transmission shaft. Claim 1, as amended, further recites that the axially displaceable body is lockable in a form-fitting and rotationally fixed manner with the roller bearing outer race.

Claim 2 depends from claim 1 and further recites that the parking lock mechanism includes a locking mechanism that is locked when the parking lock mechanism is engaged. Claim 2 further recites that the roller bearing outer race includes a gearing arranged

on an end face inside the transmission housing configured to rotationally fix and form-fittingly connect to the axially displaceable body.

Claim 10 relates to a parking lock mechanism for an automotive transmission by which a transmission shaft mounted with roller bearings is lockable with respect to a transmission housing. Claim 10 recites that the parking lock mechanism includes a roller bearing outer race, a means for connecting the roller bearing outer race in a form-fitting, rotationally fixed manner to the transmission housing, and an axially displaceable body connectable in a rotationally fixed manner to the transmission shaft. Claim 10, as amended, further recites that the axially displaceable body is lockable in a form-fitting and rotationally fixed manner with the roller bearing outer race.

Kuemmich et al. purportedly relate to a shifting device for claw clutches. The shifting device is stated to include a main shaft 10 supported by bearings 8 and 9 in a housing 11. See col. 2, lines 11 to 15. Hub 22 is stated to be fastened to housing 11 by means of screws 21. See col. 2, lines 26 to 27. Element 16 is stated to be provided with claws 19 which can be brought into engagement with counter claws 20 of hub 22. See col. 2, lines 24 to 26.

The Final Office Action alleges that Kuemmich et al. disclose a means for connecting the roller bearing outer race in a form fitting rotationally fixed manner to the transmission housing. The Final Office Action further alleges that element 22 is attached to bearing outer race 9 and element 22 is connected to housing 11 via gear wheel 12. See Final Office Action at p. 3. Nowhere, however, does the Final Office Action allege, nor do Kuemmich et al. disclose, or even suggest, an arrangement configured to connect the roller bearing outer race in a form-fitting, rotationally fixed manner to the transmission housing, as recited in claim 1. Further, the Final Office Action does not allege, nor do Kuemmich et al. disclose, or even suggest, a means for connecting the roller bearing outer race in a form-fitting, rotationally fixed manner to the transmission housing and an axially displaceable body connectable in a rotationally fixed manner to the transmission shaft, as recited in claim 10.

→ Nowhere do Kuemmich et al. disclose, or even suggest, that bearing outer race 9 is rotationally fixed to the transmission housing. Kuemmich et al. merely state that element 22 (not bearing outer race 9) is connected to transmission housing 11 via screws 21. See col. 2, lines 26 to 27. Further, nowhere do Kuemmich et al. disclose, or even suggest, that the axially displaceable body is lockable in a form-fitting and rotationally fixed manner with the roller bearing outer race, as recited in claims 1 and 10. As indicated above, element 16 is

stated to be provided with claws 19 which can be brought into engagement with counter claws 20 of hub 22. See col. 2, lines 24 to 26. Accordingly, claws 19 directly engage hub 22 not bearing outer race 9, and thus are not lockable and rotationally fixed with bearing outer race, as recited in claims 1 and 10. Therefore, Applicant respectfully submits that Kuemmich et al. do not disclose all of the limitations of claims 1 and 10.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Kuemmich et al. do not disclose, or even suggest, an arrangement configured to connect the roller bearing outer race in a form-fitting, rotationally fixed manner to the transmission housing, as recited in claim 1. Nor do Kuemmich et al. disclose, or even suggest, a means for connecting the roller bearing outer race in a form-fitting, rotationally fixed manner to the transmission housing and an axially displaceable body connectable in a rotationally fixed manner to the transmission shaft, as recited in claim 10. Further, nowhere do Kuemmich et al. disclose, or even suggest, that the axially displaceable body is lockable in a form-fitting and rotationally fixed manner with the roller bearing outer race, as recited in claims 1 and 10. Therefore, Kuemmich et al. do not anticipate claims 1 and 10.

In summary, it is respectfully submitted that Kuemmich et al. do not anticipate claims 1 and 10. Therefore, withdrawal of the 35 U.S.C. §102(b) rejection and allowance of claims 1 and 10 is respectfully requested.

As for claim 2, which depends from claim 1 and therefore includes all of the limitations of claim 1, Applicant respectfully submits that claim 2 is patentable for at least the reasons provided above in support of the patentability of claim 1. Therefore, withdrawal of the 35 U.S.C. §102(b) rejection and allowance of claim 2 is respectfully requested.

IV. Rejection of Claims 6 and 9 Under 35 U.S.C. § 102(b)

Claims 6 and 9 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 6,073,502 (“Wallace”). It is respectfully submitted that Wallace does not anticipate claims 6 and 9 for the following reasons.

Claim 6 relates to a roller bearing outer race. Claim 6 recites that the roller bearing outer race includes gearing engageable with a corresponding gearing and includes an arrangement configured for form-fitting torque transmission to a transmission housing. Claim 6 further recites that the gearing of the roller bearing outer race is arranged on a face of the roller bearing outer race.

Claim 9 relates to a roller bearing outer race. Claim 9 recites that the roller bearing outer race includes means for form-fitting torque transmission to a transmission housing and a gearing arranged on a face of the roller bearing outer race engageable with a corresponding gearing.

Wallace purportedly relates to a power takeoff device. Customer gear bank 69 is stated to be in meshed engagement with transmission gear 45 and input ratio gear bank 71 is stated to be meshed with gear teeth 81 in cluster output gear 83. See col. 6, lines 19 to 23. Transmission gear 45 is stated to be connected to shaft 43 and gear teeth 8 are stated to be connected to shaft 29. See col. 5, lines 24 to 26 and col. 6, lines 23 to 27. Input ratio gear bank 71 is stated to rotate about shaft 47 via bearings 73 and cluster output gear 83 is stated to be fixed to rotatable output shaft 29. See col. 5, lines 44 to 48 and col. 6, lines 19 to 29.

The Final Office Action alleges that Wallace discloses an arrangement configured or a means for form-fitting torque transmission to a housing. See Final Office Action at p. 3. Respectfully, torque transmitted from gear bank 71 to output gear 83 is not transmitted to housing 31 because output shaft 29 is rotatable and idler shaft 47 is rotatably supported via bearings 73. See col. 5, lines 44 to 48 and col. 6, lines 19 to 29. Accordingly, any torque transmission is to the gears and not to the housing. Therefore, Wallace does not disclose, or even suggest, a roller bearing outer race including an arrangement configured for form-fitting torque transmission to a transmission housing, as recited in claim 6, nor a roller bearing outer race including means for form-fitting torque transmission to a transmission housing, as recited in claim 9. Accordingly, Wallace does not disclose all of the limitations of claims 6 and 9 and, therefore, does not anticipate claims 6 and 9. Therefore, withdrawal of the 35 U.S.C. §102(b) rejection and allowance of claims 6 and 9 is respectfully requested.

V. Rejection of Claims 3 and 4 Under 35 U.S.C. § 103(a)

Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuemmich et al. in view of U.S. Patent No. 5,800,072 ("Buch et al."). Applicant respectfully submits that claims 3 and 4 are allowable for the following reasons.

Claim 3 depends from claim 1 and further recites a roller bearing pair including the roller bearing outer race. Claim 3 further recites that the roller bearing pair supports the transmission shaft in an X arrangement. Claim 3 further recites that the roller bearing outer race includes a gearing configured to rotationally fix and form-fittingly connect with the axially displaceable body arranged on an inside of the X arrangement.

Claim 4 depends from claim 3 and further recites that the gearing is arranged on the inside of the X arrangement on an end face.

Claims 3 and 4 ultimately depend from claim 1. As indicated above, Kuemmich et al. do not disclose all of the limitations of claim 1. Specifically, Kuemmich et al. do not disclose, or even suggest, an arrangement configured to connect the roller bearing outer race in a form-fitting, rotationally fixed manner to the transmission housing or that the axially displaceable body is lockable in a form-fitting and rotationally fixed manner with the roller bearing outer race, as recited in claim 1. Nor do Buch et al. cure the deficiencies of Kuemmich et al. Therefore, the combination of Kuemmich et al. and Buch et al. does not disclose all of the limitations of claims 3 and 4.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As stated above, the combination of Kuemmich et al. and Buch et al. fails to disclose, or even suggest, each and every feature of claim 1. It is therefore respectfully submitted that the combination of Kuemmich et al. and Buch et al. does not render obvious claims 3 and 4, which ultimately depend from claim 1. Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claims 3 and 4 is respectfully requested.

VI. Rejection of Claim 5 Under 35 U.S.C. § 103(a)

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuemmich et al. in view of Buch et al. and further in view of U.S. Patent No. 4,782,719 ("Yarnell"). Applicant respectfully submits that claim 5 is allowable for the following reasons.

Claim 5 ultimately depends from claim 1 and further recites that the arrangement includes a pin connection including multiple pins configured to form-fittingly and rotationally fixedly connect the roller bearing outer race with the transmission housing. Claim 5 further recites that the transmission housing includes a light metal cast part.

As indicated above, Kuemmich et al. do not disclose all of the limitations of claim 1. Specifically, Kuemmich et al. do not disclose, or even suggest, an arrangement configured to connect the roller bearing outer race in a form-fitting, rotationally fixed manner to the transmission housing or that the axially displaceable body is lockable in a form-fitting and rotationally fixed manner with the roller bearing outer race, as recited in claim 1. Nor do Buch et al. or Yarnell cure the deficiencies of Kuemmich et al. Therefore, the combination of Kuemmich et al., Buch et al. and Yarnell does not disclose all of the limitations of claim 5, which ultimately depends from claim 1. In view of the foregoing, it is respectfully submitted that the combination of Kuemmich et al., Buch et al. and Yarnell does not render obvious claim 5.

Moreover, it is respectfully submitted that the cases of *In re Fine, supra*, and *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Final Office Action's generalized assertions that it would have been obvious to modify or combine the reference do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Final Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the reference relied upon. In particular, the Court in the case of *In re Fine* stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of *In re Jones* stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

The Final Office Action's allegation that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kuemmich et al. in view of Buch et al. such that the housing was a light metal casted part, in further view of Yarnell, to reduce weight (Final Office Action at p. 4) is completely unsupported and is based on Applicant's own application. Specifically, Applicant's Specification states the following:

In another example embodiment of the present invention, a high torque transmission capability of the roller bearing outer race to the transmission housing is achieved through multiple pins. The use of multiple pins is possible without any manufacturing-related tolerance problems because using a lightweight cast metal for the transmission housing allows the material to yield within certain limits. This gives a uniform distribution of torque among the individual pins the first time a load is applied to the parking lock mechanism.

See page 3, line 15 to 23. None of the patents or publications relied upon mention or refer to the motivation alleged in the Final Office Action for making the proposed combination.

The apparent reliance on Applicant's Specification makes plain that the present rejection is based on nothing more than impermissible hindsight. As stated by the Federal Circuit in the case of *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999):

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher"

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. . . . Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight.

In re Dembiczak, 50 U.S.P.Q.2d at 1617 (citations omitted).

Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation, outside of Applicant's application, for modifying or combining the references to provide the claimed subject matter. Merely stating that use of a light metal casted part would reduce weight does not provide sufficient motivation absent a teaching or suggestion of such a need.

More recently, the Federal Circuit in the case of *In re Kotzab* has made plain that even if a claim concerns a "technologically simple concept" -- which is not the case here -- there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed," stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

Accordingly, there is no evidence that the references relied upon, whether taken alone, combined or modified, would provide the features and benefits of claim 5.

Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claim 5 is respectfully requested.

VII. Rejection of Claims 7 and 8 Under 35 U.S.C. § 103(a)

Claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as unpatentable over Wallace in view of Buch et al. Applicant respectfully submits that claims 7 and 8 are allowable for the following reasons.

Claim 7 depends from claim 6 and further recites that the roller bearing outer race includes a component of an angular roller bearing forming an X arrangement with a second angular roller bearing to support a transmission shaft, which is lockable with respect to the transmission housing. Claim 7 further recites that the gearing of the roller bearing outer race is arranged on an inside end face with respect to the X arrangement.

Claim 8 depends from claim 7 and further recites that the arrangement configured for form-fitting torque transmission includes a pin connection.

Applicant submits that the combination of Wallace and Buch et al. does not disclose all of the limitations of claim 6, from which claims 7 and 8 ultimately depend. Specifically, the combination of Wallace and Buch et al. does not disclose, or even suggest, an arrangement configured for form-fitting torque transmission to a transmission housing, as recited in claim 6. As indicated above, torque transmitted from gear bank 71 to output gear 83 is not transmitted to housing 31 because output shaft 29 is rotatable and idler shaft 47 is rotatably supported via bearings 73. See col. 5, lines 44 to 48 and col. 6, lines 19 to 29. Accordingly, the combination of Wallace and Buch et al. does not disclose all of the limitations of claims 7 and 8 and, therefore, does not render obvious claims 7 and 8. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claims 7 and 8 is respectfully requested.

VIII. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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